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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,397	01/30/2004	Tomoyuki Ito	008601-0307943	2672

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EXAMINER

MONDT, JOHANNES P

ART UNIT	PAPER NUMBER
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3663

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,397	Applicant(s) ITO ET AL.	
	Examiner JOHANNES P. MONDT	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-20, 24-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/7/08 has been entered.

Response to Amendment

2. Amendment filed with said RCE forms the basis for this Office Action. In said Amendment applicant substantially amended all claims, including elected claims 11, 13, 14, 30 and added new claim 32.

Specification

3. The amendment filed 8/7/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the insertion of the comma changes the meaning of the original text of [0024] in that substantially is changed from adverb of "without varying" to adverb of "inserted"..

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

4. Applicant's arguments filed 8/7/08 have been fully considered but they are not persuasive.

As a preliminary comment, applicant's request for supervisory review is misplaced, because, as any professional patent agent knows, supervisory review can be requested (a) at any time only for non-primary examiners, but not for primary examiners, however (b) said review is automatic with the filing of an Appeal, and, leaving aside petitionable matters, which do not appear to be relevant at the present time, it appears that applicant made an error filing a request for continued examination. Examiner cannot undo this error, and has to proceed with an action on the merits.

Returning to the substance of the traverse: as repeatedly indicated, the claim language is replete with functional language, making multiple sets of identifications of parts that meet the claim language, and poly-interpretability, almost unavoidable. Examiner, being confronted with such claim language, has many more parts in the structure than positively recited elements in the claim, for which he takes no responsibility at all.

With regard to the traverse of the rejection under 35 USC 112, first and second paragraph, arguments are persuasive. However, per new amendment the elongated tubular member of said apparatus body is "sized to be suspended and substantially inserted into the jet pump", in other words: sized in relation to a jet pump, while no jet pump has been positively recited. The question is thus raised whether the claim is

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directed to an apparatus as claimed, or to a combination including apparatus. This is a direct result of applicant's insistence on functional language, starting right in the beginning with the preamble. The reason why "jet pump" is not positively recited is that the limitation "for performing an operation....." (lines 1-4) is functional language.

With regard to the traverse of the rejections under 35 USC 103(a), while examiner regrets the reference to guide rod 136 on line 2 of page 4 as a remnant of a previous identification, and in what is an identification of the apparatus body, the identification of 'guide rod' where said identification is actually made and can be expected is clearly 'insertion subassembly' 144 with 'positioning tube portion'. Applicant's traverse based on the lack of attachment to an end portion of the apparatus body is entirely after the fact, per current amendment, line 9 of claim 1. By said amendment the rejections over Paillaman et al have been overcome. Further consideration and search yielded the rejections included in the present office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. ***Claims 11, 13, 14, 30 and 32*** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, according to preamble, the claim is drawn to a subcombination, i.e., the claimed apparatus (100 in the Specification) while structural limitations of components of said apparatus sub-

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combination are claimed such as to depend on members of a combination including a jet pump and its side opening. Therefore, the preamble is directed to a different invention than the bulk of the claim, which renders the claim indefinite. The components of said apparatus as claimed have properties, such as size and structure that clearly depend on a jet pump, its size, and the size of a side opening therein, as is evidenced for example by the limitations on apparatus body having elongated tubular member “sized to be suspended and substantially inserted into the jet pump” (lines 5-6 of claim 1), and the “inclined guide rod “ “being structured to facilitate entry of the guide rod into the tapered surface of the jet pump side opening” (lines 10-12 of claim 1). Therefore, the structural properties of components of the apparatus depend on properties of a jet pump and its side opening not even positively recited in the claim, which renders the limitations for said properties indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. ***Claims 11, 13, 14 and 30*** are rejected under 35 U.S.C. 102(b) as being anticipated by Levesque et al (US 6,076,407) (made of record in IDS filed 3/1/06).

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N.B.: The rejection is provided subject to the noted indefiniteness under 35 USC 112, second paragraph, as detailed above, to the best understanding of examiner, whereby examiner assumes that the preamble correctly indicates that the invention is drawn to the sub-combination, i.e., the apparatus.

N.B.: Examiner, once again, notes that the claims are replete with functional language, statements that recite that an element is “for performing” a certain function or being structured to facilitate. Said recitation is not a positive limitation but only requires the ability to perform, or facilitate, given the structure, i.e., it does not constitute a limitation in any patentable sense (see *In re Hutchison*, 69 USPQ 138).

Levesque et al teach an apparatus *capable* of performing an operation inside a vessel of a nuclear reactor that includes a jet pump with an inlet mixer, a nozzle, and a side opening with a tapered surface, the side opening being positioned between the inlet mixer and the nozzle. If only because no size relation between opening and apparatus or any of its components is specified), the apparatus comprising:

an apparatus body 12/13 (incl. 20) (‘probe head’ **12**; col. 3, l. 14+ with element **13**) having an elongated tubular member (elongated housing’ with a single diameter; col. 3, l. 15 and col. 6, l. 20) **13**; whether said apparatus body is sized to be suspended and substantially inserted as claimed depends on dimensions of a jet pump not positively recited in the claim and hence constitutes functional language;

a tool (any of the sensor assemblies **32** (col. 4, l. 56+) *capable* of performing an operation within an interior of a jet pump, given that the dimensions of the particular jet pump are adequately large; and

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a guide rod **20** ('flexible joints': col. 5, l. 34+) or **20/16** (16 being any of or all of the 'guide arms'; col. 3, l. 14-16) attached to an end (i.e., lower) portion of the apparatus body, having an incline (col. 3, l. 53-62) at a predetermined angle (angle can be set: loc.cit.), the inclined guide rod being structured to facilitate entry of the guide rod into any tapered surface of any jet pump side opening, given adequately large dimension of said tapered side opening,

wherein, after the guide rod is inserted into any side opening the apparatus body is capable of being lowered so that both apparatus body and guide rod are substantially inserted into a jet pump having such side opening given sufficiently large dimensions of the same, and to enable the tool to perform the operation (see Figure 3 and see col. 5, l. 28-58).

In summary on functional language: the following limitations are merely functional and thus have only patentable weight in as much as the *capability* to perform the function is met:

- (a) 'for performing an operation.....the nozzle' (see lines 1-4 of claim 1);
- (b) sized to be suspended....into the jet pump' (lines 5-6 of claim 1);
- (c) for performing the operation....jet pump' (lines 7-8 of claim 1);
- (d) being structured to facilitate entry of the guide rod....side opening' (lines 11-12 of claim 1);
- (e) wherein, after the guide rod....to perform the operation' (lines 13-15 of claim 1).

Functional language is indicated from beginning to end of quote.

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On claim 13: the guide rod is structured to be freely and movable supported at the end portion of the apparatus body by virtue of the guide rod 20 being flexible (col. 3, l. 53-62) and hence is *capable* of being inclined at the predetermined angle with respect to the vertical axis due to the gravitational force. The limitation, once again, is one of functional language, while the capability is clearly met for the reason outlined here.

On claim 14: the limitation is met due to the flexibility of the guide rod, implying a *capability* to return to predetermined angle setting with respect to the body, given to external force acting on it.

On claim 30: the guide rod is structured to be adaptively varied by a moveable support so that an orientation of the guide rod corresponds to an interior surface of a jet pump as the guide rod is inserted into said jet pump, given adequate dimensions of a jet pump and a side opening thereof, Because said guide rod is so structured with regard to a pipe, while, given no information of the relative openings of pipe and jet pump there is full equivalence between adaptation to one over the other. Again, the limitation is one of functional language, whereas the capability to perform the indicated function is possible for the claimed sub-combination, given adequate dimensions for other components in a combination.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHANNES P. MONDT whose telephone number is (571)272-1919. The examiner can normally be reached on 7:30 - 17:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johannes P Mondt/
Primary Examiner, Art Unit 3663